

REMARKS**I. General**

Claims 1, 4, 10, 17-23, and 25-28 are pending in the present application, and claims 1, 4, 10, 17 and 26-28 are withdrawn from consideration as being directed to non-elected claims. The outstanding issues in the current Office Action are as follows:

- Claims 18, 19, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the telephone book THE ONE BOOK FOR NORTHERN VIRGINIA for 1993 (hereinafter, *One Book*).
- Claims 18, 19, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *One Book*.
- Claims 18, 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over HAWAIIAN AIRLINES IN PARADISE, July 1989, (hereinafter, *Hawaiian Airlines*) in view of the *One Book*.

Applicant respectfully requests withdrawal of the rejections in light of the amendments and remarks contained herein.

II. Rejections Under 35 U.S.C. §102(b)

On page 3 of the Office Action claims 18, 19, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the *One Book*. Applicant traverses the rejection and asserts the claims are allowable, at least, for the reasons stated below.

In order for a claim to be properly rejected under 35 U.S.C. § 102(b), the applied reference must teach each and every element of the claimed invention. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the ...claim.”

M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Applicant respectfully asserts that the rejection does not satisfy these requirements.

The Examiner on page 3 of the Office Action rejects claims 18, 19, and 25 as being anticipated by the *One Book* (the Northern Virginia phone book). In order to use the *One Book* as a reference, the Examiner has taken official notice of one fact, and made four factual findings to come to the conclusion that the *One Book* is a magazine, and that advertisements in the phone book are articles. The mere fact that the Examiner had to resort to four factual findings and one official notice to call the phone book a magazine shows the fallacy of the assertion. Applicant traverses the factual findings as incorrect and unsupported by evidence. The Examiner finds (erroneously even with his chosen definition) that a telephone book (*One Book*) is a magazine, which he defines as “a periodical containing miscellaneous pieces (as articles, stories, poems) often illustrated.” Page 9 of the Office Action. In contrast to the Examiner’s definition as a magazine, the dictionary definition of a telephone book is “a **book** listing names, addresses, and telephone numbers of the telephone subscribers.” WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 2350 (Philip Babcock Gove Ph.D. ed., Merriam-Webster Inc. 1986) (emphasis added). Thus, the phone book is a book and not a magazine as required by the limitations of claim 18. Therefore, the *One Book* does not show the identical invention in as complete detail as contained in the claim.

Moreover, the *One Book* does not contain “a plurality of general interest articles dispersed throughout,” as recited in claim 18. An article is defined as a “non-fictional prose composition.” WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 123 (Philip Babcock Gove Ph.D. ed., Merriam-Webster Inc. 1986). The Examiner’s chosen definition of an article is “a distinct often number[ed] section of a writing,” which most likely refers to an article in a legal document and would not apply in the present case. Applicant asserts that the white and yellow pages are not “non-fictional prose compositions,” or even “distinct often number[ed] section of a writing,” and therefore not general interest articles. The white pages are a compilation of names and corresponding phone numbers, and the yellow pages are a compilation of businesses, services, and products. See THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Houghton Mifflin Co., 4th ed. 2000), available at <http://dictionary.reference.com/search> (defining white pages as a “volume or section of a telephone directory that alphabetically lists the names of people and sometimes businesses,”

and yellow pages as a “volume or section of a telephone directory that lists businesses, services, or products alphabetically according to field”). The Examiner also points to recycling information and coupons as articles. Again, Applicant asserts that coupons and recycling information are not articles as defined in the dictionary (non-fictional prose composition) or as defined by the Examiner (a distinct often numbered section of a writing). The Examiner seems to concede this fact because his next factual assertion is that the advertisements are the articles. An advertisement is defined as “a public notice.” WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 31 (Philip Babcock Gove Ph.D. ed., Merriam-Webster Inc. 1986). An advertisement would not be considered an article by one of ordinary skill in the art. Indeed, Applicant has distinguished the content of the promotional publication of the present invention over typical advertisements as having a viable editorial climate that increases the appeal, the desirability and the credibility of products. *See* page 6, lines 12-16 of the Application. Therefore, the *One Book* does not contain any “general interest articles dispersed throughout” as required by claim 18. *One Book* does not anticipate claim 18 because it does not show the identical invention in as complete detail as contained in the claim.

Claim 18 also recites “a coupon keyed to said at least one of said articles containing said brand specific information.” The Examiner’s rejection of record fails to address this claim limitation. Moreover, the *One Book* does not teach this limitation. As discussed above, the *One Book* does not contain articles containing brand specific information, or coupons keyed to the articles. Therefore, the Examiner’s 35 U.S.C. § 102 rejection of record is improper because the applied reference does not teach each and every element as set forth in the claim. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 102 rejection of claim 18.

Applicant has challenged and conclusively rebutted the Examiner’s factual assertions used to establish that a phone book is a magazine by showing that the assertions do not comport to ordinary dictionary definitions of the facts he is trying to define. Applicant requests that the Examiner provide, in the next Office Action, documentary evidence that the phone book is a magazine, and that the yellow pages (including advertisements in the yellow pages), white pages, coupons, and recycling information are general interest articles, and that it is old and well known in the art to key coupons for brand specific products to other articles,

or withdraw the rejection. “If [A]pplicant adequately traverses the [E]xaminer’s assertion of official notice, the [E]xaminer must provide documentary evidence in the next Office Action if the rejection is to be maintained. M.P.E.P. § 2144(C) (citing 37 C.F.R. § 1.104(c)(2) and *Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) ([T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test)).

On page 4 of the Office Action, the Examiner states it is his “principle position that the claims are anticipated because of the inherencies the *One Book* contains articles.” If this is the Examiner principle position, then he needs to provide evidence, instead of factual findings to back up his argument. “[W]hen the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. M.P.E.P. § 2131.01 (citing *Continental Can Co. USA v. Monsanto Co.*, F.2d 1264,1268 (Fed. Cir. 1991). Applicant respectfully requests that the Examiner provide the necessary evidence or withdraw the 35 U.S.C. § 102(b) rejection of record.

Claims 19 and 25 depend from and inherit all of the limitations of independent claim 18, shown above to be patentable over the applied art. Therefore, claims 19 and 25 are patentable over the applied art, at least, in their dependence from claim 18. Moreover, claims 19 and 25 teach additional novel and non-obvious limitations not disclosed in the applied art.

For example, claim 19 recites “wherein said magazine is specific to a particular store.” The *One Book* does not meet this claim language. As discussed above, the *One Book* is not a magazine. Moreover, there is nothing about the *One Book* that makes it specific to a particular store. By definition the phone book is not specific to a particular store. It is a compilation of names of stores and businesses. Indeed, the Examiner relies upon the advertisement for pet supplies appearing in the *One Book* as an article. These advertisements each reference different pet centers. Clearly the *One Book* is not specific to a particular store. Therefore, the applied art does not show the identical invention in as complete detail as required for rejection under 35 U.S.C. § 102. Accordingly, Applicant respectfully requests withdrawal of 35 U.S.C. § 102 rejection of record.

Claim 25 recites “wherein said at least one of said articles includes within its confines references to specific brand information pertaining to products other than said identified product.” The *One Book* does not anticipate the limitations of this claim. As discussed above, the *One Book* is not a magazine, does not contain general interest articles that mention brand information pertaining to products other than said identified product. Therefore, the applied art does not show the identical invention in as complete detail as required for rejection under 35 U.S.C. § 102. Accordingly, Applicant respectfully requests withdrawal of 35 U.S.C. § 102 rejection of record.

III. Rejections Under 35 U.S.C. §103(a)

On page 4 of the Office Action claims 18, 19, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *One Book*. On page 4 of the Office Action claims 18, and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hawaiian Airlines* in view of the *One Book*. Applicant traverses the rejection and asserts the claims are allowable, at least, for the reasons stated below.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143. Applicant respectfully asserts that the rejection does not satisfy these requirements.

A. Rejections over *One Book*

The Examiner rejects claims 18, 19, and 25 as being unpatentable over the *One Book*. On page 4 of the Office Action, the Examiner explains that he was postulating in the § 102 rejection that the phone book (*One Book*) inherently contained general interest articles, but now seemingly concedes that the phone book does not have any general interest articles by postulating that it would be obvious to a person having ordinary skill in the art at the time of the invention to modify the phone book to include general interest articles. However, “if [a] proposed modification would render the prior art invention being modified unsatisfactory for

its intended purpose then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Modifying a phone book (*One Book*) to contain “a plurality of general interest articles dispersed throughout,” as required by claim 18, would render the phone book unsatisfactory for its intended purpose. The whole purpose of a phone book (*One Book*) is to be a directory of an alphabetical listing of names and businesses, such that a person needing to find a number can easily locate the number in the phone book. Dispersing a plurality of general interest articles throughout the phone book obscures the directory structure of the phone book, and hinders the process of looking up a phone number. Thus, the proposed modification would make the phone book unsatisfactory for its intended purpose (to be a directory of names). Therefore, there is no suggestion or motivation to modify the *One Book* as suggested by the Examiner, and as required for a proper rejection of claim 18 under 35 U.S.C. § 103.

Moreover, the combination suggested by the Examiner does not teach or suggest all of the claim limitations. Claim 18 recites “a plurality of general interest articles dispersed throughout the magazine.” As discussed above, the *One Book* is not a magazine. See WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 2350 (Philip Babcock Gove Ph.D. ed., Merriam-Webster Inc. 1986) (defining phone book as “a **book** listing names, addresses, and telephone numbers of the telephone subscribers”) (Emphasis added). Therefore, the combination does not teach or suggest all of the limitations of claim 18 as required for rejection under 35 U.S.C. § 103.

Claim 18 also recites “a coupon keyed to said at least one of said articles containing said brand specific information.” As discussed above, the *One Book* does not teach or suggest this limitation, nor was it addressed as teaching this limitation by the Examiner. Even if general interest articles were dispersed throughout the phone book, which there is no motivation to do, the modified *One Book* still does not teach or disclose coupons keyed to those articles. Therefore, the combination does not teach or suggest all of the limitations of claim 18 as required for rejection under 35 U.S.C. § 103.

Further, the Examiner has not established his *prima facie* case because the “initial burden is on the [E]xaminer to provide some suggestion of the desirability of doing what the

inventor has done. M.P.E.P. § 2142. In this case, the Examiner merely states that it would have been obvious to disperse general interest articles in the *One Book*. The Examiner does not establish his *prima facie* case of obviousness under 35 U.S.C. § 103 because he does not state why it would have been obvious to someone skilled in the art to modify the phone book to contain general interest articles. Therefore, the Examiner fails to meet his burden for establishing a *prima facie* case of obviousness for claims 18, 19, and 25. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

Claims 19 and 25 depend from and inherit all of the limitations of independent claim 18, shown above to be patentable over the applied art. Therefore, claims 19 and 25 are patentable, at least, in their dependence from claim 18. Moreover, claims 19 and 25 teach additional novel and non-obvious limitations not disclosed in the applied art.

For example, claim 19 recites “wherein said magazine is specific to a particular store.” The *One Book* does not teach or suggest this claim language. As discussed above, the *One Book* is not a magazine. Moreover, there is nothing about the *One Book* that makes it specific to a particular store. By definition the phone book is not specific to a particular store. It is a compilation of all the names of people, stores, and businesses in a covered area. Assuming *arguendo* that the *One Book* is modified, as suggested by the Examiner, to include a plurality of general interest articles, it still does not teach or suggest the *One Book* being specific to a particular store, or the *One Book* being a magazine. The modified *One Book* would still be a book containing a compilation of names that by definition are not specific to a particular store. Moreover, making the *One Book* particular to a specific store would render it unsatisfactory for its intended purpose. Therefore, the combination does not teach or suggest all of the limitations of claim 19 as required for rejection under 35 U.S.C. § 103.

Claim 25 recites “said at least one of said article includes within its confines reference to specific brand information pertaining to products other than said identified product.” The applied reference does not meet this limitation because it contains no general interest articles, and modifying the *One Book* to contains such would destroy its intended purpose. Therefore, the combination does not teach or suggest all of the limitations of claim 19 as required for rejection under 35 U.S.C. § 103.

B. Rejections over *Hawaiian Airlines* in view of *One Book*

On page 4 of the Office Action the Examiner rejects claims 18, 20-23 under 35 U.S.C. § 103 as being unpatentable over *Hawaiian Airlines* in view of the *One Book*. The rejection is improper because there is no motivation or suggestion to combine the references and the combination does not teach all of the claim limitations.

Claim 18 recites “a coupon keyed to said at least one of said articles containing said brand specific information.” The Examiner, on page 5 of the Office Action, admits that *Hawaiian Airlines* does not teach or suggest this limitation by stating “*Hawaiian Airlines* does not directly disclose a coupon.” The Examiner asserts the that combining *Hawaiian Airlines* to and the alleged brand specific coupons of *One Book* would teach this limitation of claim 18. However, *One Book* does not teach or suggest coupons keyed to articles containing brand specific information. As discussed above, *One Book* has advertisements, but it does not have general interest articles containing brand specific information. Modifying *Hawaiian Airlines* to contain *One Book*’s advertisements and coupons does not meet this limitation of claim 18. Specifically, there is nothing to teach or suggest modifying such a coupon to relate to an article of *Hawaiian Airlines* rather than the advertisement of the *One Book*. Moreover, there is nothing to teach or suggest keying the coupon to an article of *Hawaiian Airlines* as require by the claim. Therefore, the proposed combination does not teach or suggest all of the claim limitations of claim 18 as required for rejection under 35 U.S.C. §103.

The rejection of record merely cobbles together a promotional magazine with a coupon and concludes that the invention would have been obvious without properly addressing the requirement in the claim that the coupon be keyed to a general interest article containing brand specific information. When considering the limitations of the claim, the Examiner’s rejection is without merit. There is no motivation or suggestion to combine the coupons linked to advertisements in the *One Book* with the articles in *Hawaiian Airlines*. Even if combined they do not anticipate the present invention unless you further modify the coupons to be keyed to the general interest articles, and the only motivation for that modification comes from the present invention’s disclosure. The Examiner uses impermissible hindsight to find a motivation for the combination, as well as to read limitations of the present invention into the references. See M.P.E.P. § 2142 (stating that “impermissible hindsight must be avoided and the legal conclusion must be reached on the

basis of facts gleaned from the prior art”). In fact, the Examiner’s rejection on page 5 sounds like an endorsement of the present invention.

Moreover, the Examiner has not established a *prima facie* case of obviousness because he incorrectly asserts that *One Book* “discloses coupons keyed to articles containing brand specific information.” Page 5 of the Office Action. *One Book* discloses advertisements referring to coupons, but not coupons keyed to articles containing brand specific information. In the Examiner’s rejection of claim 18, he uses impermissible hindsight based on the applicant’s own disclosure to promulgate incorrect factual findings (general interest articles are the same as the advertisements in *One Book*) that allows him to read elements into the applied references (i.e., coupons keyed to articles containing brand specific information), and to find the motivation to combine the applied references (when the motivation is not present in the references themselves). M.P.E.P. § 2142. Therefore, the Examiner fails to meet the burden of factually supporting a *prima facie* case of obviousness. Accordingly, Applicant respectfully request withdrawal of the 35 U.S.C. § 103 rejection of claim 18.

Claims 20-23 depend, either directly or indirectly, from and inherit all of the limitations of independent claim 18, shown above to be patentable over the applied art. Therefore, claims 20-23 are patentable, at least, in their dependence from claim 18. Moreover, claims 20-23 contain addition novel and non-obvious limitations not disclosed in the applied references.

For example, claim 20 recites “**each** of said articles which contains specific brand information is authored under commission by a sponsor of the specific brand in said article.” Emphasis added. Even assuming *arguendo*, as the Examiner asserts, Hawaiian Airlines commissioned the article about Hawaiian Airlines (as a specific brand within an article), as well as the whole magazine (both points not conceded by the Applicant), the applied references do not teach or suggest that articles mentioning other brand information were commissioned by that specific brand sponsor. Therefore, the combination of the applied references do not teach or suggest this claim limitation as required for rejection under 35 U.S.C. § 103. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 20.

Claim 21 recites “each of said articles which contains specific brand information is authored under commission of a specific store.” Applicant would point out that an airline is not a store. Thus, the Examiner rejection is incorrect in its assertion that a specific store (Hawaiian Airlines) commissioned the articles which contain specific brand information. Therefore, neither reference (*One Book* was not cited for teaching or suggesting this limitation by the Examiner) teaches or suggests this limitation. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 21.

Claim 22 recites “the name of said specific store appears on the front cover of said magazine.” The Examiner asserts that this limitation is met by Hawaiian Airlines appearing on the front cover of the magazine. However, Applicant still points out that an airline is not a store. Therefore, the applied references (*One Book* was not cited for teaching or suggesting this limitation by the Examiner) do not meet this limitation of claim 22. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 22.

Claim 23 recites “the content of **each** of said articles which contains specific brand information is controlled at least in part by a sponsor of the specific brand in said article.” Emphasis added. Assuming *arguendo* that Hawaiian Airlines has some control over content of the articles, the applied references do not teach or suggest that **each** of the articles which contains specific brand information is controlled at least in part by a sponsor of the specific brand in the article. Therefore, the applied references (*One Book* was not cited for teaching or suggesting this limitation by the Examiner) do not meet this limitation of claim. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record for claim 23.

IV. Addressing the Examiner’s Points 14-17

Point 14-16. The Examiner questions whether or not the Applicant has been his own lexicographer. Applicant has not asserted that he is his own lexicographer. However, the Applicant cannot allow the Examiner to use factual finding to define words contrary to Applicant’s disclosure, and to the word’s ordinary and customary meaning. Applicant disagrees with the meanings used by the Examiner. Giving claim terms their ordinary and customary meaning does not mean using a factual findings to create new meanings.

Applicant asserts that the ordinary and customary meaning of a book is not a magazine (Examiner's assertion that the phone book is a magazine), that general interest articles are not advertisements (Examiner asserts that the advertisements are general interest articles), and that an airline is not a store (Examiner asserts that Hawaiian Airline is a store). Therefore, Applicant traverses the meanings asserted by the Examiner through his official notice and factual findings as discussed throughout this response.

Point 17. The Examiner finds that it is old and well known in the art to key coupons for brand name products to other articles. Applicant traverses this statement and request the Examiner to provide an affidavit or declaration setting forth specific factual statement for this assertion. "If the [E]xaminer is relying on personal knowledge to support the finding of what is know in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." M.P.E.P. § 2144.04(C) (citing 37 C.F.R. § 1.104(d)(2)). Moreover, the Examiner evidence needs to meet the claim language "a coupon keyed to said at least one of said articles containing said brand specific information" when providing an affidavit or declaration.

V. Addressing the Examiners Response to Arguments

Point 18 and 19. Applicant asserts that the Examiner's 102(b) rejection is improper for the reasons discussed above. Therefore, the declarations must be considered.

Point 20. Applicant traverses the Examiners finding that the declarations by Caleb J. Pirtle do not provide the proper nexus linking the general interest article to the promotional success stated in the declaration. As described on page 7-9 of Applicants Appellate Brief, Caleb J Pirtle believes that Dockery House, the assignee of the present application, has obtained a large share of the mature promotional magazine market due to their providing a magazine that contains a plurality of general interest articles, wherein at least one of the articles makes reference to an identified product including specific brand information pertaining thereto, with coupons keyed to the articles containing brand specific products. Moreover, Applicant provides support for his belief with a letter from Sally Beauty Company stating that they believed their increased coupon redemption rate to be a result of the Dockery House promotion magazines use of general interest articles incorporating a product and having coupons therewith. Additional letters are provided by other customers (Lifestyle

Vacation Incentive, Consumer Solutions, and FirstUp, Inc.) supporting the conclusion that Dockery House customers purchase Dockery House promotional magazines to obtain the benefits of the unique promotional technique which is the subject of the present application. Combining the above letters with the fact that Dockery House obtained a sizable amount of the market offering promotional magazines by incorporating the invention of the present claims, provides the required nexus linking the present invention to the commercial success.

To state that the declaration does not provide the proper nexus linking the general interest articles to the promotional successes stated in the declaration reflects the Examiner's misunderstanding of the invention. The claimed invention is a magazine for use in promoting the purchase of specific products. Applicant's declaration clearly and unequivocally shows commercial success of the magazines i.e., purchase of magazines and acclamation by the market, which employ the inventive features set forth in the claim. Applicant respectfully requests that the Examiner not focus on the success of the promotions contained within the magazine and focus on the promotional magazines which are the subject of the claim. However, if the Examiner requires evidence of the success of the promotions included in the magazines, the Examiner's attention is directed to the declaration submitted August 7, 2000. Applicant notes, however, that this declaration showing success of the various promotions (in the coupon redemption rate) was dismissed by the previous Examiner as not showing the proper nexus between the claimed invention and the commercial success shown.

Point 21. Applicant traverses the Examiner's finding that the general interest articles in "Sally" are advertisements just like the advertisements in the *One Book*. Because there is not an "indicia separating general interest stories from advertisements" in "Sally," the Examiner's arbitrarily finds that the general interest articles are the same as the advertisements in the *One Book*. In fact, the lack of indication that the general interest articles are advertisements supports the opposite conclusion (the general interest articles are different from the advertisements in the *One Book*). As discussed above there are no general interest articles in the *One Book*. There are only advertisement that do not meet the definition of an article (non-fictional prose composition). However, there are general interest articles in "Sally" that meet the definition of an article. For example, two such articles in "Sally" are prose compositions describing such things as a method of skin care treatment to make you hands soft, including tricks used by hand models, and also a composition describing a girls

day with the theme of the article being an in home spa party. *See SALLY*, January/February 2002 at 16, 21-27.

Point 22. The Examiner states that he has no context for the 5% share of the promotional advertising market. As discussed above, achieving 5% of a \$100,000,000 mature market is an indication of commercial success. A 5% penetration into an already established and mature market is a considerable business achievement. In an attempt to give the Examiner requested context, 5% of a \$100,000,000 market amounts to annual sales of \$5,000,000. This combined with the customers letters, discussed in the Appellant's Brief, provide the nexus to show commercial success. For example, the letter from Sally Beauty Company states "[w]e believe the increased coupon redemption rate is a result of the way Dockery House Publishing provides product placement and corresponding coupons in general interest articles [and therefore] Sally will continue to purchase promotional product magazine programs from Dockery House Publishing so we can take advantage of this promotional technique." Similarly, as discussed above, the letter from Lifestyle Vacation Incentives states that they are moving to the Dockery House promotional magazines "to take advantage of the unique way in which Dockery House Publishing provides a promotional magazine in which general interest articles incorporate a product being promoted, as well as includes coupons for the promoted products corresponding to these articles." Accordingly, it is clear that the commercial success (indicated by the 5% penetration of a mature market) of their promotional magazine programs are directly connected to implementation of the invention of the present application. *See Appellant's Brief* page 8-9.

Point 23. Although the "Cole Letter" mentions that in some instances the coupon redemption has reached as high as 10%, when a general interest article incorporates a product and includes a coupon, the Examiner rejects this argument as out of context because no mention is made of the coupon redemption rate in promotional material that does not use the claimed invention. Again, Applicant would point out that the present invention is a magazine for use in promoting the purchase of specific products, and not the coupons themselves. The "Sally" letter, as well as the other letters, show commercial success because the authors of those letters are the purchasers of the of the present invention, and they give testimonials about how well the invention works. However, if the Examiner still intends to parse the context of the 10% redemption rate, then in the declaration submitted by Caleib J. Pirtle on

August 7, 2000, he states the national redemption rate for all types of coupons is within a range of 0.25-0.5%. The national average includes not only those coupons found in promotion magazines, but also other coupons from direct mailing and newspapers, which typically are redeemed at a higher rate than magazine coupons. Thus, all of the evidence including the coupon redemption rate, the "Cole Letter," the other letters, and the declarations show that the present invention is a commercial success.

The Examiner further discounts the Cole letter because she did not mention that the coupon was a brand name coupon. Although the Cole letter did not recite the claim language for the Examiner, she did say that the general interest articles incorporates a product and includes a coupon. When this statement is viewed in light of Sally magazine, the Examiner should be able to relate this statement to the claim limitation that recites "a coupon keyed to said at least one of said articles containing said brand specific information." *See* Declaration submitted by Caleb J. Pirtle on March 28, 2002, paragraph 3 (describing an embodiment of Dockery House invention implemented in Sally magazine containing the coupon for the Jilbere Smooth, Straight & Shiny Iron presented upon page 24, and the corresponding article entitled "Turn Up the Volume!" appearing upon pages 30-33).

Point 24. Applicant respectfully request that the Examiner reconsider the declarations in light of the arguments contained herein.

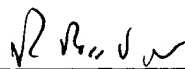
VI. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 58569/P001US/10007125 from which the undersigned is authorized to draw.

Dated: July 13, 2005

Respectfully submitted,

By 

R. Ross Viguet

Registration No.: 42,203

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8185

(214) 855-8200 (Fax)

Attorney for Applicant